

WIPO

PCT/R/WG/7/4

ORIGINAL: English

DATE: April 5, 2005

WORLD INTELLECTUAL PROPERTY ORGANIZATION

GENEVA

**INTERNATIONAL PATENT COOPERATION UNION
(PCT UNION)****WORKING GROUP ON REFORM OF THE PATENT
COOPERATION TREATY (PCT)****Seventh Session
Geneva, May 25 to 31, 2005****PUBLICATION OF INTERNATIONAL APPLICATIONS
IN MULTIPLE LANGUAGES***Document prepared by the International Bureau***SUMMARY**

1. This document contains further revised proposals for amendment of the Regulations under the PCT¹ to provide for the publication of international applications in multiple languages. Applicants would have the option of submitting translations, into languages other than the usual language of publication, for publication by the International Bureau. This possibility would be useful for applicants wishing to ensure the “prior art effect” of their applications and/or to establish a basis for “provisional protection” in designated States whose national laws provide that such effect or protection is dependent on publication of a translation.

¹ References in this document to “Articles” and “Rules” are to those of the Patent Cooperation Treaty (PCT) and the Regulations under the PCT (“the Regulations”), or to such provisions as proposed to be amended or added, as the case may be. References to “national laws”, “national applications”, “the national phase”, etc., include reference to regional laws, regional applications, the regional phase, etc.

2. Earlier proposals, discussed at the sixth session of the Working Group, have been revised taking into account the discussions, and the agreement reached, at that session and the comments received on preliminary draft documents made available since then. The main differences in comparison with the proposals considered at the sixth session concern the following: (i) the additional languages in which the applicant may request international publication to take place; and (ii) the furnishing of translations of changes (amendments, rectifications of obvious errors) and of indications in relation to deposited biological material.

3. This document also contains other proposed language-related amendments of the Regulations which are not directly related to the proposed amendments concerning international publication in multiple languages but which appear to be necessary even if the latter do not proceed.

BACKGROUND

4. During its third session, the Working Group discussed a proposal for deletion of Article 64(4), based on document PCT/R/WG/3/1, Annex II, item 28. The Working Group agreed that further consideration of this matter should be deferred until progress had been made in discussions of prior art issues by the Standing Committee for the Law of Patents (SCP). As a related matter, the Working Group agreed, however, that the International Bureau should look into the possibility of amending Rule 48 so as to provide for the electronic publication by the International Bureau of translations, furnished by the applicant, of the international application (see the summary of the Chair of the third session of the Working Group, document PCT/R/WG/3/5, paragraphs 78 to 82).

5. For the fourth session of the Working Group, the International Bureau prepared a proposal to amend Rule 48 so as to require the International Bureau, on request by the applicant, to publish, together with the international application, any translation of the international application furnished by the applicant or, where the international application was filed in a language which was not a language of publication, the international application in the language in which it was filed (see Annex III of document PCT/R/WG/4/4). However, having regard to the time available for discussion during the fourth session, discussions on this proposal were deferred until the fifth session of the Working Group.

6. At the fifth session of the Working Group, discussions on the proposals to amend Rule 48 were again deferred, following an explanation by the International Bureau that further study and consultation was needed.

7. At its sixth session, the Working Group discussed revised proposals for amendment of the Regulations concerning the publication of international applications in multiple languages, taking into account the comments received on previous draft proposals. The discussions are outlined in document PCT/R/WG/6/12, paragraphs 138 to 143, reproduced in the following paragraphs:

“INTERNATIONAL PUBLICATION IN MULTIPLE LANGUAGES

“138. Discussions were based on document PCT/R/WG/6/8.

“139. The Working Group invited the Secretariat to prepare revised proposals, for consideration at its next session, taking into account the comments and suggestions set out in the following paragraphs.

“140. One delegation confirmed that the proposal as presently drafted would achieve its primary objective of establishing prior art effect of the international application concerned under its national law. In view of this confirmation, the proposal was supported by two other delegations. One of those emphasized, however, the need to discuss a possible revision of Article 64(4) at some stage in the future.

“141. One delegation and one representative of users, while welcoming the proposals in relation to the question of prior art effect, stated that the effects of international publication in an additional language other than those relating to prior art effect ought to be further examined and kept in mind as further proposals were developed. Such other effects included, for example, the affording of “provisional protection” to published applications (see Article 29).

“142. One representative of users suggested that international publication in additional languages should not be restricted to languages of publication under the PCT, that there should be a longer time limit for submitting translations for publication, that additional language versions should be published only in electronic form as documents downloadable from the Internet, and that the fee for publication should vary depending on the particular electronic format in which a translation was provided.

“143. One representative of users, while not opposed to the proposals *per se*, expressed concern that publication of international applications in multiple languages was out of line with one of the basic aims of the Treaty, namely, to give effect under multiple national laws to an international application filed in a single language. The representative suggested that the additional costs involved would deter most applicants from using the proposed system, and that the underlying issue concerning the prior art effect of published international applications should be dealt with in the context of the consideration by WIPO’s Standing Committee on the Law of Patents of a proposed Substantive Patent Law Treaty.”

8. The Annex to the present document contains further revised proposals, taking account of the suggestions made by delegations and representatives of users at the sixth session (see document PCT/R/WG/6/12, paragraphs 138 to 143, reproduced in paragraph 7, above) and also of comments received on preliminary drafts for the seventh session of the Working Group which were made available for comment on the WIPO website as PCT/R/WG/7 Paper No. 3 and Paper No. 3 Rev. The main features of the revised proposals are outlined in the following paragraphs.

INTERNATIONAL PUBLICATION IN MULTIPLE LANGUAGES

9. International publication and communication to designated Offices of the international application in more than one language would be beneficial for the establishment or protection of certain rights of the applicant under the national law of designated States. This will be the case, first, in designated States where the prior art effect of an international application is, in accordance with Article 64(4), dependent on the international publication of the international application in a language accepted by the Office of the designated State concerned. Second, there are designated States where provisional protection of an international application is, in accordance with Article 29, dependent on the publication or availability of the international application in a language in which publications under the national law of the designated State concerned are effected.

10. It is thus proposed to amend the PCT Regulations so as to allow for the international publication of translations of the international application in one or more languages beyond that in which the international publication takes place under Article 21(4) and Rule 48.3.

11. Under the Regulations as proposed to be amended, the applicant may request, within a time limit of 17 months from the priority date, that the international application be published, in addition to the "usual" language in which the international application is published under Rule 48.3(a) or (b), in one or more additional languages.

12. Where the international application was filed in a language different from the language in which it is published under Rule 48.3(a) or (b) and the applicant requests publication in that language of filing, the international application would be published in both the language of publication referred to in Rule 48.3(a) and in the language in which it was filed. The applicant may also request publication in an additional language which was not the language of filing, in which case the applicant would have to furnish a translation of the international application into the additional language and the international application would then be published in both the language of publication referred to in Rule 48.3(a) and the additional language.

13. For the purposes of international publication in an additional language, the applicant would have to pay a special fee. The translation into an additional language would have to contain the following elements (unless such element had already been furnished in that language):

(i) the international application itself (that is, the description, including the title of the invention, where applicable, as established by the International Searching Authority under Rule 37; the claim or claims; any text matter in the drawings; and the abstract, where applicable, as established by the International Searching Authority under Rule 38);

(ii) any amendment under Article 19 and any statement filed under Article 19(1);

(iii) any rectification of an obvious error referred to in Rule 91.1(e)(ii) (that is, any rectification of an error in any part of the international application other than the request); and

(iv) any indications in relation to deposited biological material referred to in Rule 13*bis*.4 furnished separately from the description.

14. International publication in the additional language would not take place where the applicant did not, within the applicable time limit, pay the special fee for publication or furnish the required translations.

15. As indicated above, in general, the time limit for requesting publication in the additional language, for the payment of the special fee for publication, and for the furnishing of the required translations would be 17 months from the priority date. It is to be noted, however, that the time limit for making amendments under Article 19 (and for filing the statement under Article 19(1)) may, in certain circumstances, under Rule 46.1, expire after the expiration of that 17-month time limit, and even after international publication of the international application concerned. Furthermore, where the International Searching Authority has established the title and/or the abstract under Rules 37 and 38, respectively, the applicant may need further time to translate those elements into the additional language. It is

thus proposed that any translation into the additional language of an amendment under Article 19 or statement under Article 19(1), or of the title and the abstract as established by the International Searching Authority, may be filed within two months from the date of transmittal of the international search report to the International Bureau and to the applicant by the International Searching Authority, or 17 months from the priority date, whichever time limit expires later. If such a translation is furnished after completion of technical preparations for international publication of the international application in the additional language but within that time limit, the international application would have to be republished in the additional language.

16. As regards the additional languages in which the applicant may request that international publication take place, it is no longer proposed, as it was in document PCT/R/WG/6/8, to limit those languages to the "languages of publication" referred to in Rule 48.3(a). As suggested at the sixth session (see the summary of the sixth session by the Chair, document PCT/R/WG/6/12, paragraph 142, reproduced in paragraph 7, above), it is now proposed that the applicant be allowed to request publication of the international application in any additional language.

17. The International Bureau would not, however, be able to establish, for the purposes of international publication, a standardized front page of the published international application in a language not being one of the languages of publication referred to in Rule 48.3(a). It is thus proposed that, where the additional language is not one of the languages of publication referred to in Rule 48.3(a), the front page relating to such international application would always be published in both English and French. The data contained on the front page is always available at the International Bureau in both those languages, since the Gazette in electronic form, which contains the same data elements as the front page, is published in both English and French. Where the additional language is one of the languages of publication referred to in Rule 48.3(a), the front page relating to such international application would, of course, be published in that language of publication.

OTHER PROPOSED AMENDMENTS

18. This document also contains certain proposed amendments which are not directly related to the proposed amendments concerning international publication in multiple languages but which would appear necessary even if the latter were not agreed upon. In particular, it is proposed:

(i) to add a new Rule 12.1*bis* to fill a gap in the present Regulations which do not provide for the language in which indications related to deposited biological material furnished under Rule 13*bis*.4 separately from the description are to be filed;

(ii) to amend Rule 12.2(c) to fill a gap by adding a reference to a translation furnished under Rule 12.4;

(iii) to amend Rules 12.2(c) and 55.2 to clarify that the check for, and the correction of, defects under Rule 11 in translations furnished under Rule 55.2(a) for the purposes of international preliminary examination is carried out by the International Preliminary Examining Authority; and

(iv) to amend Rule 48.3(c) to clarify that, where the international application is published in a language other than English, the translation required for such international publication shall be prepared under the responsibility of the International Bureau only if it is not furnished by the applicant under Rule 12.3 (or proposed new Rule 12.5).

19. The Working Group is invited to consider the proposals contained in the Annex to this document.

[Annex follows]

ANNEX

PROPOSED AMENDMENTS OF THE PCT REGULATIONS:²

PUBLICATION OF INTERNATIONAL APPLICATIONS IN MULTIPLE LANGUAGES

TABLE OF CONTENTS

Rule 12	Language of the International Application and Translations <u>Translation</u> for the Purposes of International Search and International Publication.....	3
12.1	<i>Languages Accepted for the Filing of International Applications</i>	3
12.1bis	<u><i>Language of Indications Furnished Under Rule 13bis.4</i></u>	4
12.2	<i>Language of Changes in the International Application</i>	4
12.3	<i>Translation for the Purposes of International Search</i>	6
12.4	<i>Translation for the Purposes of International Publication</i>	7
12.5	<u><i>Additional Translations for the Purposes of International Publication</i></u>	8
Rule 26	Checking by, and Correcting Before, the Receiving Office of Certain Elements of the International Application.....	14
26.1 to 26.2bis	[No change].....	14
26.3	<i>Checking of Physical Requirements Under Article 14(1)(a)(v)</i>	14
26.3bis	[No change].....	14
26.3ter	<i>Invitation to Correct Defects Under Article 3(4)(i)</i>	15
26.4 to 26.6	[No change].....	15
Rule 37	Missing or Defective Title.....	16
37.1	[No change].....	16
37.2	<i>Establishment of Title</i>	16
Rule 38	Missing or Defective Abstract.....	17
38.1	[No change].....	17
38.2	<i>Establishment of Abstract</i>	17
Rule 43	The International Search Report.....	18
43.1 to 43.3	[No change].....	18
43.4	<i>Language</i>	18
43.5 to 43.10	[No change].....	18
Rule 46	Amendment of Claims Before the International Bureau.....	19
46.1 and 46.2	[No change].....	19
46.3	<i>Language of Amendments</i>	19
46.4	<i>Statement</i>	19
46.5	[No change].....	19
Rule 47	Communication to Designated Offices.....	20
47.1 and 47.2	[No change].....	20
47.3	<i>Languages</i>	20
47.4	[No change].....	21

² Proposed additions and deletions are indicated, respectively, by underlining and striking through the text concerned. Certain provisions that are not proposed to be amended may be included for ease of reference.

Rule 48	International Publication.....	22
48.1	<i>Form and Means</i>	22
48.2	<i>Contents</i>	22
48.3	<i>Languages of Publication</i>	26
48.4 to 48.6	[No change]	27
Rule 49	Copy, Translation and Fee Under Article 22	28
49.2	<i>Languages</i>	28
49.3 to 49.6	[No change]	29
Rule 55	Languages (International Preliminary Examination)	30
55.1	<i>Language of Demand</i>	30
55.2	<i>Translation of International Application</i>	30
55.3	[No change].....	32
Rule 66	Procedure Before the International Preliminary Examining Authority.....	33
66.1 to 66.8	[No change]	33
66.9	<i>Language of Amendments</i>	33
Rule 70	International Preliminary Report on Patentability by the International Preliminary Examining Authority (International Preliminary Examination Report)	34
70.1 to 70.16	[No change]	34
70.17	<i>Languages of the Report and the Annexes</i>	34
Rule 74	Translations of Annexes of the International Preliminary Examination Report and Transmittal Thereof.....	35
74.1	<i>Contents of Translation and Time Limit for Transmittal Thereof</i>	35

Rule 12

**Language of the International Application
and Translations ~~Translation~~ for the Purposes of International Search
and International Publication**

12.1 *Languages Accepted for the Filing of International Applications*

(a) [No change]

(b) Each receiving Office shall, for the filing of international applications, accept at least one language which is both:

(i) [No change] a language accepted by the International Searching Authority, or, if applicable, by at least one of the International Searching Authorities, competent for the international searching of international applications filed with that receiving Office, and

(ii) a language referred to in Rule 48.3(a) ~~of publication~~.

(c) Notwithstanding paragraph (a), the request shall be filed in any language referred to in Rule 48.3(a) ~~of publication~~ which the receiving Office accepts for the purposes of this paragraph.

(d) [No change]

[COMMENT: The proposed amendments are consequential on the proposed amendment of Rule 48.3(a) and (b) (see below).]

12.1bis Language of Indications Furnished Under Rule 13bis.4

Any indication in relation to deposited biological material furnished under Rule 13bis.4 shall be in the language in which the international application is filed, provided that, where a translation of the international application is required under Rule 12.3(a) or 12.4(a), any such indication shall be filed in both the language in which the application is filed and the language of that translation.

[COMMENT: It is proposed to add new Rule 12.1bis so as to fill an apparent gap in the present Regulations which do not provide for the language in which indications related to deposited biological material furnished under Rule 13bis.4 separately from the description are to be filed. Note that this proposed amendment is not directly related to the proposed amendments concerning international publication in multiple languages and, if agreed upon, should be presented to the Assembly for adoption even if the proposed amendments concerning international publication in multiple languages are not agreed upon.]

12.2 Language of Changes in the International Application

(a) [No change] Any amendment of the international application shall, subject to Rules 46.3, 55.3 and 66.9, be in the language in which the application is filed.

(b) Any rectification under Rule 91.1 of an obvious error in the international application shall be in the language in which the application is filed, provided that:

(i) where a translation of the international application is required under Rule 12.3(a), 12.4(a) or 55.2(a), rectifications referred to in Rule 91.1(e)(ii) and (iii) shall be filed in both the language in which ~~of~~ the application is filed and the language of that translation;

[Rule 12.2(b)(i), continued]

[COMMENT: Note that paragraph (b) would have to be further amended should the proposed amendments to the Regulations concerning the rectification of obvious mistakes (see document PCT/R/WG/7/6) be adopted.]

(ii) [No change]

(c) Any correction under Rule 26 of a defect in the international application shall be in the language in which the international application is filed. Any correction under Rule 26 of a defect in a translation of the international application furnished under Rule 12.3 or 12.4, any correction under Rule 12.5(f) of a defect in a translation furnished under Rule 12.5(b), any correction under Rule 55.2(c) of a defect in a translation furnished under Rule 55.2(a), or any correction of a defect in a translation of the request furnished under Rule 26.3ter(c), shall be in the language of the translation.

[COMMENT: Rule 12.2(c) as worded at present would appear to incorrectly imply that the check for, and correction of, defects under Rule 11 in a translation furnished under Rule 55.2(a) is made “under Rule 26” and thus by the receiving Office rather than by the competent International Preliminary Examining Authority to which such a translation is to be furnished. It is therefore proposed to amend paragraph (c) so as to clarify that a correction of a translation furnished under Rule 55.2(a) is done “under Rule 55.2(c)” and thus by the International Preliminary Examining Authority (see also Rule 55.2 as proposed to be amended, below). Furthermore, it is proposed to amend Rule 12.2(c) by adding a reference to a translation furnished under Rule 12.4, noting that it would appear that the addition of such reference was overlooked when Rule 12.4 was added to the Regulations. Note that these proposed amendments are not directly related to the proposed amendments concerning international publication in multiple languages and, if agreed upon, should be presented to the Assembly for adoption even if the proposed amendments concerning international publication in multiple languages are not agreed upon. It is further proposed to amend paragraph (c) to add a reference to a translation furnished under proposed new Rule 12.5, consequential on the proposed addition of that new Rule.]

12.3 *Translation for the Purposes of International Search*

(a) Where the language in which the international application is filed is not accepted by the International Searching Authority that is to carry out the international search, the applicant shall, within one month from the date of receipt of the international application by the receiving Office, furnish to that Office a translation of the international application into a language which is all of the following:

(i) [No change]

(ii) a language referred to in Rule 48.3(a) ~~of publication~~, and

(iii) a language accepted by the receiving Office under Rule 12.1(a), unless the international application is filed in a language referred to in Rule 48.3(a) ~~of publication~~.

(b) to (e) [No change]

[COMMENT: The proposed amendments are consequential on the proposed amendment of Rule 48.3(a) and (b) and the proposed addition of new Rule 48.3(b-bis) (see below).]

12.4 *Translation for the Purposes of International Publication*

(a) Where the language in which the international application is filed is not a language referred to in Rule 48.3(a) of publication and no translation is required under Rule 12.3(a), the applicant shall, within 14 months from the priority date, furnish to the receiving Office a translation of the international application into any language referred to in Rule 48.3(a) of publication which the receiving Office accepts for the purposes of this paragraph.

(b) to (e) [No change]

[COMMENT: The proposed amendments are consequential on the proposed amendment of Rule 48.3(a) and (b) and the proposed addition of new Rule 48.3(b-*bis*) (see below).]

12.5 Additional Translations for the Purposes of International Publication

(a) The applicant may, within the applicable time limit under paragraph (g), make a request to the International Bureau that the international application be published, in addition to the language in which it is to be published under Rule 48.3(a) or (b), in another language (“additional language”). Such requests may be made in respect of more than one additional language in relation to the same international application.

[COMMENT: See paragraph 16 in the main body of this document.]

(b) A request under paragraph (a) shall be accompanied by a special publication fee whose amount shall be fixed in the Administrative Instructions and by a translation into the additional language of:

(i) the international application, unless it was filed in the additional language or a translation into the additional language has already been furnished under Rule 12.3;

[COMMENT: With regard to the contents of the translation of the international application under paragraph (b)(i), see paragraph (c), below.]

(ii) any amendment under Article 19 and any statement under Article 19(1);

(iii) any rectification of an obvious error referred to in Rule 91.1(e)(ii), unless such rectification has already been filed in the additional language under Rule 12.2(b)(i);

[Rule 12.5(b)(iii), continued]

[COMMENT: Note that item (iii) would have to be further amended should the proposed amendments to the Regulations concerning the rectification of obvious errors (see PCT/R/WG/7/6) be adopted.]

(iv) any indication in relation to deposited biological material referred to in Rule 13bis.4, unless such indication has already been furnished in the additional language under Rule 12.1bis.

[COMMENT: With regard to the consequences of non-compliance with the requirements of Rule 12.5(a) and (b) (for example, non-payment of fees, missing translations, etc., see Rule 48.3(b-bis) and (b-ter), below).

(c) For the purposes of paragraph (b)(i), the translation of the international application shall contain:

(i) the description (other than any sequence listing part of the description), including, where applicable, the title established by the International Searching Authority under Rule 37.2;

[COMMENT: Note that the title prepared by the applicant is part of the description (see Rule 5.1(a)) and would thus be included in the translation of the description into the additional language.]

(ii) the claim or claims;

(iii) any text matter in the drawings; and

[Rule 12.5(c), continued]

(iv) the abstract as filed by the applicant or, where applicable, as established by the International Searching Authority under Rule 38.2.

[COMMENT: Note that paragraph (c) would have to be further amended should the proposed amendments of the Regulations concerning the incorporation by reference of certain elements and parts (see document PCT/R/WG/7/2) be adopted.]

(d) The translation of any text matter in the drawings referred to in paragraph (c)(iii) shall be furnished either in the form of a copy of the original drawing with the translation pasted on the original text matter or in the form of a drawing executed anew.

[COMMENT: Proposed new paragraph (d) is modeled on present Rule 49.5(d).]

(e) Where a request under paragraph (a) is not accompanied by the special publication fee or a required translation referred to in paragraph (b), the International Bureau shall invite the applicant to pay that fee or to furnish that required translation, as the case may be, within the applicable time limit under paragraph (g).

[COMMENT: With regard to the consequences where the applicant does not comply with the invitation within the applicable time limit, see Rule 48.3(b-bis), below).

[Rule 12.5, continued]

(f) The International Bureau shall check any translation referred to in paragraph (b) furnished by the applicant for compliance with the physical requirements referred to in Rule 11 to the extent that compliance therewith is necessary for the purpose of reasonably uniform international publication, and shall invite the applicant to correct any defect within the time limit under paragraph (g).

[COMMENT: With regard to the consequences where the applicant does not comply with the invitation within the applicable time limit, see Rule 48.3(b-bis), below).

(g) The time limit referred to in paragraphs (a), (e) and (f) shall be 17 months from the priority date, provided that:

[COMMENT: See paragraphs 9 to 16 in the main body of this document. In general, it is proposed that any request for the publication of the international application in an additional language of publication (see proposed new Rule 12.5, above) and any translation into such a language would have to be furnished within 17 months from the priority date, noting that sufficient time is needed by the International Bureau in order to prepare international publication in the additional language. It is not proposed, as had been suggested by a representative of users at the sixth session (see the summary of the sixth session by the Chair, document PCT/R/WG/6/12, paragraph 142), to provide for an even longer time limit than 17 month from the priority date for the furnishing of the translation, noting that, in order to have the intended effects concerning prior art and provisional protection, publication of the international application in the additional language has to be part of the “international publication” under Article 21 and thus has to take place promptly after the expiration of 18 months from the priority date.]

[Rule 12.5(g), continued]

(i) the time limit referred to in paragraph (e) for the furnishing of a translation of the title or the abstract established by the International Searching Authority under Rule 37.2 and 38.2, respectively, as required under paragraphs (b)(i) and (c), and of an amendment under Article 19 and a statement under Article 19(1) as required under paragraph (b)(ii), and the time limit referred to in paragraph (f) for the furnishing of any correction of such translation, shall be two months from the date of transmittal of the international search report to the International Bureau and to the applicant by the International Searching Authority or 17 months from the priority date, whichever time limit expires later;

[COMMENT: See paragraph 15 in the main body of this document.]

(ii) any translation of a rectification of an obvious error required under paragraph (b)(iii), and any correction of such translation referred to in paragraph (f), furnished after the expiration of 17 months from the priority date shall be considered to have been received on the last day of that time limit if it reaches the International Bureau before the technical preparations for international publication have been completed;

[COMMENT: As regards the translation of any rectification of an obvious error, it is proposed to, in effect, extend the 17-month time limit up to the point of completion of technical preparations for international publication, noting that, under present Rule 91, the applicant may request rectification of an obvious error in the international application (other than the request) up to that point in time (note further that, in order to be effective, the authorization for rectification given by the International Searching Authority must also reach the International Bureau before the completion of technical preparation for international publication (see present Rule 91.1(g)(i) and (g-bis)). Note that item (i) would have to be further amended should the proposed amendments to the Regulations concerning the rectification of obvious mistakes (see document PCT/R/WG/7/6) be adopted.]

[Rule 12.5(g), continued]

(iii) where the applicant makes a request for early publication under Article 21(2)(b), any request under paragraph (a), any translation under paragraph (b) or any correction under paragraph (f) submitted, or any fee under paragraph (b) paid, after the technical preparations for international publication have been completed shall be considered as not having been submitted or paid in time.

[COMMENT: Where the applicant has requested early publication of the international application, all acts required for the international publication of the international application in the additional language must have been performed by the applicant before the completion of technical preparations for international publication; otherwise, the international application will not be published in the additional language.]

Rule 26

**Checking by, and Correcting Before, the Receiving Office
of Certain Elements of the International Application**

26.1 to 26.2*bis* [No change]

26.3 Checking of Physical Requirements Under Article 14(1)(a)(v)

(a) Where the international application is filed in a language referred to in Rule 48.3(a)
~~of publication~~, the receiving Office shall check:

(i) and (ii) [No change]

(b) Where the international application is filed in a language which is not a language
referred to in Rule 48.3(a) ~~of publication~~, the receiving Office shall check:

(i) and (ii) [No change]

[COMMENT: The proposed amendments are consequential on the proposed amendment of Rule 48.3(a) and (b) (see below).]

26.3*bis* [No change]

26.3ter Invitation to Correct Defects Under Article 3(4)(i)

(a) Where the abstract or any text matter of the drawings is filed in a language which is different from the language of the description and the claims, the receiving Office shall, unless

(i) [No change]

(ii) the abstract or the text matter of the drawings is in the language in which the international application is to be published under Rule 48.3(a) or (b),

invite the applicant to furnish a translation of the abstract or the text matter of the drawings into the language in which the international application is to be published under Rule 48.3(a) or (b). Rules 26.1(a), 26.2, 26.3, 26.3*bis*, 26.5 and 29.1 shall apply *mutatis mutandis*.

[COMMENT: The proposed amendments are consequential on the proposed amendment of Rule 48.3(a) and (b) (see below).]

(b) and (c) [No change]

26.4 to 26.6 [No change]

Rule 37

Missing or Defective Title

37.1 [No change]

37.2 Establishment of Title

If the international application does not contain a title and the International Searching Authority has not received a notification from the receiving Office to the effect that the applicant has been invited to furnish a title, or if the said Authority finds that the title does not comply with Rule 4.3, it shall itself establish a title. Such title shall be established in the language in which the international application is to be published under Rule 48.3(a) or (b), or, if a translation into another language was transmitted under Rule 23.1(b) and the International Searching Authority so wishes, in the language of that translation.

[COMMENT: The proposed amendments are consequential on the proposed amendment of Rule 48.3(a) and (b) (see below).]

Rule 38

Missing or Defective Abstract

38.1 [No change]

38.2 *Establishment of Abstract*

(a) If the international application does not contain an abstract and the International Searching Authority has not received a notification from the receiving Office to the effect that the applicant has been invited to furnish an abstract, or if the said Authority finds that the abstract does not comply with Rule 8, it shall itself establish an abstract. Such abstract shall be established in the language in which the international application is to be published under Rule 48.3(a) or (b), or, if a translation into another language was transmitted under Rule 23.1(b) and the International Searching Authority so wishes, in the language of that translation.

[COMMENT: The proposed amendments are consequential on the proposed amendment of Rule 48.3(a) and (b) (see below).]

(b) [No change]

Rule 43

The International Search Report

43.1 to 43.3 [No change]

43.4 *Language*

Every international search report and any declaration made under Article 17(2)(a) shall be in the language in which the international application to which it relates is to be published under Rule 48.3(a) or (b), or, if a translation into another language was transmitted under Rule 23.1(b) and the International Searching Authority so wishes, in the language of that translation.

[COMMENT: The proposed amendments are consequential on the proposed amendment of Rule 48.3(a) and (b) (see below).]

43.5 to 43.10 [No change]

Rule 46

Amendment of Claims Before the International Bureau

46.1 and 46.2 [No change]

46.3 *Language of Amendments*

~~Any If the international application has been filed in a language other than the language in which it is published, any amendment made under Article 19 shall be in the language in which the international application is published under Rule 48.3(a) or (b) of publication.~~

[COMMENT: The proposed amendments are consequential on the proposed amendment of Rule 48.3(a) and (b) (see below).]

46.4 *Statement*

(a) The statement referred to in Article 19(1) shall be in the language in which the international application is published under Rule 48.3(a) or (b). ~~The statement and~~ shall not exceed 500 words if in the English language or if translated into that language and. ~~The statement shall be identified as such by a heading, preferably by using the words “Statement under Article 19(1)” or their equivalent in the language of the statement.~~

[COMMENT: The proposed amendments are consequential on the proposed amendment of Rule 48.3(a) and (b) (see below).]

(b) [No change]

46.5 [No change]

Rule 47

Communication to Designated Offices

47.1 and 47.2 [No change]

47.3 *Languages*

(a) The international application communicated under Article 20 shall be in the language in which it is published under Rule 48.3(a) or (b) and, where applicable, in each additional language in which it is published under Rule 48.3(b-bis).

[COMMENT: The proposed amendments are consequential on the proposed amendment of Rule 48.3(a) and (b) and the proposed addition of new Rule 48.3(b-bis) (see below). Note that, in accordance with Rule 93bis.1 (“communication on request”), the communication of any document by the International Bureau to a designated Office will only be effected on request by that Office, so that any designated Office would be free to waive the receipt of the published international application under Article 20 altogether, or to request to receive the published international application in all publication languages, or to specify the publication languages in which it wishes to receive the published international application.]

(b) Where the ~~language in which the~~ international application is not published under Rule 48.3(a), (b) or (b-bis) in ~~is different from~~ the language in which it was filed, the International Bureau shall furnish to any designated Office, ~~upon the request of that Office,~~ a copy of that application in the language in which it was filed.

[COMMENT: The proposed amendments are consequential on the proposed amendment of Rule 48.3(a) and (b) and the proposed addition of new Rule 48.3(b-bis) (see below) and, as far as the proposed deletion of the text “upon request of that Office” is concerned, on the entry into force, with effect from January 1, 2004, of Rule 93bis.1 (“communication on request”), pursuant to which the communication of any document by the International Bureau to a designated Office will only be effected on request by that Office.]

47.4 [No change]

[COMMENT: Note that it is also proposed in another document to amend Rule 47 in the context of “international publication and PCT Gazette in electronic form” (see document PCT/R/WG/7/8).]

Rule 48³

International Publication

48.1 *Form and Means*

(a) ~~[Deleted] The international application shall be published in the form of a pamphlet.~~

(b) ~~The particulars regarding the form in which and the means by which international applications are published of the pamphlet and the method of reproduction shall be governed by the Administrative Instructions.~~

[COMMENT: See document PCT/R/WG/7/8. Modified Section 406 of the Administrative Instructions, which entered into force on April 1, 2005, enables the International Bureau to fulfill its legal obligation under Article 21 to publish international applications by way of electronic means. It is thus proposed to delete the term “pamphlet” throughout the Regulations, noting that that term, connoting paper publication, would appear to be misleading.]

48.2 *Contents*

(a) The publication of the international application ~~The pamphlet~~ shall contain:

[COMMENT: See document PCT/R/WG/7/8. The proposed amendments of the chapeau of paragraph (a) are consequential on the proposed deletion of the term “pamphlet” throughout the Regulations (see Rule 48.1 as proposed to be amended, above).]

³ Changes to Rule 48 are proposed in both this document and in document PCT/R/WG/7/8 relating to international publication and PCT Gazette in electronic form. Where appropriate, changes to a particular provision are repeated in both documents.

[Rule 48.2(a), continued]

(i) to (x) [No change]

[COMMENT: Note that amendments of items (i) to (x) of paragraph (a) are proposed in the context of “international publication and PCT Gazette in electronic form” (see document PCT/R/WG/7/8.)]

(b) [No change]

[COMMENT: Note that amendments of paragraph (b) are proposed in the context of “international publication and PCT Gazette in electronic form” (see document PCT/R/WG/7/8.)]

(c) to (e) [No change]

(f) to (h) [No change]

[COMMENT: Note that amendments of paragraphs (f), (g) and (h) are proposed in the context of “international publication and PCT Gazette in electronic form” (see document PCT/R/WG/7/8.)]

(i) Where the international application is published in an additional language under Rule 48.3(b-bis), the published international application shall include:

(i) if the additional language is one of the languages referred to in Rule 48.3(a), the element referred to in paragraph (a)(i) in that additional language;

[Rule 48.2(i)(i), continued]

[COMMENT: The “element referred to in paragraph (a)(i)” is the front page which, where the additional language is one of the languages referred to in Rule 48.3(a), would include the abstract.]

(ii) if the additional language is not one of the languages referred to in Rule 48.3(a), the element referred to in paragraph (a)(i) in English and in French, and the abstract, as referred to in Rule 12.5(c)(iv), in the additional language;

[COMMENT: Where the additional language is not one of the languages referred to in Rule 48.3(a), the front page (“the element referred to in paragraph (a)(i)”), including the abstract, would be published in English and French. Furthermore, the publication of the international application would contain the abstract in the additional language.]

(iii) the elements referred to in paragraphs (a)(ii) to (iv), (vi) and (viii) of this Rule, in the additional language;

[COMMENT: The “elements referred to in paragraphs (a)(ii) to (iv), (vi) and (viii)” are the description, the claims, the drawings (if any) (where applicable, as rectified under Rule 91) and any indications in relation to deposited microorganisms furnished separately from the description.]

(iv) if available at the time of the completion of the technical preparations for international publication, the elements referred to in paragraph (f) of this Rule, in the additional language.

[COMMENT: The “elements referred to in paragraph (f)” are amended claims under Article 19 and any statement under Article 19(1).]

[Rule 48.2(i), continued]

~~The Administrative Instructions shall determine the cases in which the various alternatives referred to in paragraphs (g) and (h) shall apply. Such determination shall depend on the volume and complexity of the amendments and/or the volume of the international application and the cost factors.~~

[COMMENT: The proposed deletion of the text of present paragraph (i) is consequential on the amendments of paragraphs (g) and (h) proposed in the context of “international publication and PCT Gazette in electronic form” (see document PCT/R/WG/7/8).]

(j) Where the international application is published in an additional language under Rule 48.3(b-bis) and, at the time of the completion of the technical preparations for international publication, the time limit under Rule 12.5(g) for the furnishing of a translation of the title or the abstract established by the International Searching Authority, of a translation of an amendment under Article 19 and of a statement under Article 19(1), or of any correction of such translation under Rule 12.5(f), has not expired, the front page shall refer to that fact and indicate that, promptly after receipt by the International Bureau of any such translation within the time limit under Rule 12.5(g), any such translation will be published together with a revised front page.

[COMMENT: See paragraph 15 in the main body of this document.]

48.3 *Languages of Publication*

(a) If the international application is filed in Chinese, English, French, German, Japanese, Russian or Spanish (~~“languages of publication”~~), that application shall be published in the language in which it was filed.

(b) If the international application is not filed in one of the languages referred to in paragraph (a) ~~a language of publication~~ and a translation into such ~~a language of publication~~ has been furnished under Rule 12.3 or 12.4, that application shall be published in the language of that translation.

[COMMENT: The proposed amendments are consequential on the proposed addition of new Rule 48.3(b-*bis*) (see below).]

(b-*bis*) Where the applicant makes a request complying with Rule 12.5 for publication of the international application in an additional language, the international application shall be published in that language in addition to the language in which the international application is published under paragraph (a) or (b).

[COMMENT: Where the applicant has made a request for the publication of the application in an additional language but has not met all the requirements of Rule 12.5 (for example, the special fee has not been paid in full, or required elements are missing from the translation, or the translation does not comply with the physical requirements referred to in Rule 11 to the extent necessary for the purpose of reasonably uniform publication), the international application would not be published in the additional language.]

[Rule 48.3, continued]

(c) If the international application is published under paragraph (a) or (b) in a language other than English, the international search report to the extent that it is published under Rule 48.2(a)(v), or the declaration referred to in Article 17(2)(a), the title of the invention, the abstract and any text matter pertaining to the figure or figures accompanying the abstract shall be published both in that language and in English. The translations, if not furnished by the applicant under Rule 12.3 or 12.5, shall be prepared under the responsibility of the International Bureau.

[COMMENT: The proposed amendments of the first sentence of paragraph (c) are consequential on the proposed amendment of Rule 48.3(a) and (b) (see above). The proposed addition of a reference to Rule 12.3 in the last sentence of paragraph (c) would fill an apparent gap in the present text of paragraph (c); note that this addition is not directly related to the proposed amendments concerning international publication in multiple languages and, if agreed upon, should be presented to the Assembly for adoption even if the proposed amendments concerning international publication in multiple languages are not agreed upon. Otherwise, the proposed amendment of the last sentence is consequential on the proposed addition of Rule 12.5.]

48.4 to 48.6 [No change]

[COMMENT: Note that Rule 48 is proposed to be further amended in the context of proposed amendments of the Regulations relating to missing elements and parts of the international application (see document PCT/R/WG/7/2), relating to the restoration of the right of priority (see document PCT/R/WG/7/3), relating to the rectification of obvious mistakes (see document PCT/R/WG/7/6), relating to international publication and PCT Gazette in electronic form (see document PCT/R/WG/7/8), and relating to the addition of Arabic as a language of publication (see document PCT/R/WG/7/10).]

Rule 49

Copy, Translation and Fee Under Article 22

49.1 [No change]

49.2 *Languages*

(a) The language into which translation may be required must be an official language of the designated Office, provided that no translation may be required:

(i) if the international application is filed in such a language or, if there are several of such languages, no translation may be required if the international application is in one of them; or

(ii) if the international application is published under Rule 48.3(a), (b) or (b-bis) in such a language or, if there are several of such languages, in one of them;

If there are several official languages and a translation must be furnished, the applicant may choose any of those languages.

[COMMENT: Where the international application is published under Rule 48.3(a), (b) or (b-bis) in an official language of the designated Office, or where the international application is filed in an official language of the designated Office which is different from the language in which the application is published, a copy of the international application in that official language is communicated to that designated Office by the International Bureau, upon request of that Office, under Article 20, Rule 47.3(a) or (b) and Rule 93bis. It is proposed to amend Rule 49.2(a) so as to clarify that, in those cases, the Office should not be entitled to require the applicant to furnish it with a translation.]

[Rule 49.2, continued]

(b) Notwithstanding the foregoing provisions of this paragraph (a);

(i) if there are several official languages but the national law prescribes the use of one such language for foreigners, a translation into that language may be required;

(ii) if no translation of the international application may be required under paragraph (a), the designated Office may nevertheless require a translation of the request as referred to in Rule 49.5(a)(i), in which case Rule 49.5(b) shall apply *mutatis mutandis*.

[COMMENT: The proposed addition of new item (ii) is consequential on the proposed amendment of paragraph (a) (see above): where no translation of the international application may be required by a designated Office under paragraph (a), that Office should still be entitled to request the furnishing of a translation of the request (see Rule 49.5(a)(i)), noting that a copy of the request would not be included in the copy of the international application communicated to the designated Office (in the official language of the designated Office) under Article 20, Rule 47.3(a) or (b), and Rule 93*bis*. Rule 49.5(b), which is referred to in proposed new item (ii) of paragraph (b), deals with details concerning the furnishing of a translation of the request.]

49.3 to 49.6 [No change]

Rule 55

Languages (International Preliminary Examination)

55.1 Language of Demand

The demand shall be in the language in which the international application is published under Rule 48.3(a) or (b) of the international application or, if the international application has been filed in a language other than the language in which it is published, in the language of publication. However, if a translation of the international application is required under Rule 55.2, the demand shall be in the language of that translation.

[COMMENT: The proposed amendments are consequential on the proposed amendment of Rule 48.3(a) and (b) (see above).]

55.2 Translation of International Application

(a) Where ~~neither the language in which the international application is~~ not filed nor the ~~language in which the international application is published~~ under Rule 48.3(a), (b) or (b-bis) in a language is accepted by the International Preliminary Examining Authority that is to carry out the international preliminary examination, the applicant shall, subject to paragraph (b), furnish with the demand a translation of the international application into a language which is both:

[COMMENT: The proposed amendments are consequential on the proposed amendment of Rule 48.3(a) and (b) and the proposed addition of new Rule 48.3(b-bis) (see above).]

[Rule 55.2(a), continued]

(i) [No change] a language accepted by that Authority, and

(ii) a language referred to in Rule 48.3 (a) of publication.

[COMMENT: The proposed amendments are consequential on the proposed amendment of Rule 48.3(a) and (b) (see above).]

(a-bis) The International Preliminary Examining Authority shall check any translation furnished under paragraph (a) for compliance with the physical requirements referred to in Rule 11 to the extent that compliance therewith is necessary for the purposes of the international preliminary examination.

[COMMENT: See Rule 12.2(c) as proposed to be amended, above. It is proposed to add a new paragraph (a-bis) to Rule 55.2 so as to expressly provide for the International Preliminary Examining Authority to carry out the Rule 11 check but only to the extent that compliance with Rule 11 is necessary for the purposes of international preliminary examination. Furthermore, it is proposed to amend paragraph (c) (see below) so as to expressly provide for that Authority to invite the applicant to correct any defect. Note that the proposed addition of new paragraph (a-bis) and the proposed amendments to paragraph (c) are not directly related to the proposed amendments concerning international publication in multiple languages and, if agreed upon, should be presented to the Assembly for adoption even if the proposed amendments concerning international publication in multiple languages are not agreed upon.]

(b) [No change]

[Rule 55.2, continued]

(c) If ~~a~~ the requirement referred to in ~~of~~ paragraph (a) or (a-bis) is not complied with and paragraph (b) does not apply, the International Preliminary Examining Authority shall invite the applicant to furnish the required translation or the required correction, as the case may be, within a time limit which shall be reasonable under the circumstances. That time limit shall not be less than one month from the date of the invitation. It may be extended by the International Preliminary Examining Authority at any time before a decision is taken.

[COMMENT: See comment on proposed new paragraph (a-bis), above.]

55.3 [No change]

Rule 66

**Procedure Before the
International Preliminary Examining Authority**

66.1 to 66.8 [No change]

66.9 *Language of Amendments*

(a) Subject to paragraphs (b) and (c), ~~if the international application has been filed in a language other than the language in which it is published,~~ any amendment, as well as any letter referred to in Rule 66.8, shall be submitted in the language in which the international application is published under Rule 48.3(a) or (b) of publication.

[COMMENT: The proposed amendments are consequential on the proposed amendment of Rule 48.3(a) and (b) (see above).]

(b) to (d) [No change]

Rule 70

**International Preliminary Report on Patentability by
the International Preliminary Examining Authority
(International Preliminary Examination Report)**

70.1 to 70.16 [No change]

70.17 Languages of the Report and the Annexes

The report and any annex shall be in the language in which the international application to which they relate is published under Rule 48.3(a) or (b), or, if the international preliminary examination is carried out, pursuant to Rule 55.2, on the basis of a translation of the international application, in the language of that translation.

[COMMENT: The proposed amendments are consequential on the proposed amendment of Rule 48.3(a) and (b) (see above).]

Rule 74

**Translations of Annexes of the International
Preliminary Examination Report and Transmittal Thereof**

74.1 Contents of Translation and Time Limit for Transmittal Thereof

(a) [No change]

(b) Where the furnishing under Article 39(1) of a translation of the international application is not required by the elected Office, that Office may require the applicant to furnish, within the time limit applicable under that Article, a translation into the language in which the international application was published under Rule 48.3(a) or (b) of any replacement sheet referred to in Rule 70.16 which is annexed to the international preliminary examination report and is not in that language.

[COMMENT: The proposed amendments are consequential on the proposed amendment of Rule 48.3(a) and (b) (see above).]

[End of Annex and of document]

THIS PAGE BLANK (USPTO)